

REMARKS**Amendments to Claims 1, 8 and 17**

Claims 1, 8 and 17 have been amended to limit the multi-drug resistance cancer to be selected from the group consisting of leukemia, uterine sarcoma and melanoma. Support for these amendments are found in the specification, for example, at page 20, line 25 through page 22, line 13 and Examples 15-17. No new matter has been added.

Allowable Subject Matter

Applicants respectfully acknowledge the allowance of Claims 18-29, 35 and 38-39.

Claims 36-37 were objected to as being dependent upon a rejected base claim. Claim 36 has been canceled. Claim 1 has been amended, from which Claim 37 is dependent from. Therefore, Claim 37 is in condition for allowance.

Rejection of Claims 1-17 and 30-34 under 35 U.S.C. § 112, First Paragraph

Claims 1-17 and 30-34 were rejected under 35 U.S.C. § 112, first paragraph because the specification, while being enabling for the treatment of multi-drug resistant leukemia, uterine sarcoma and melanoma, does not reasonably provide enablement for the treatment of all multi-drug resistant cancers.

Claims 1, 8 and 17 have been amended to be directed to a method of treating a multi-drug resistant cancer selected from the group consisting of leukemia, uterine sarcoma and melanoma. Therefore, Claims 1, 8 and 17, and their dependent claims are enabled by the specification, as filed, and meet the requirement of 35 U.S.C. § 112, first paragraph.

Applicants have amended the claims to expedite the prosecution and reserve the right to argue the patentability of the un-amended claims in a future application.

Rejection of Claims 1-2, 5-11, 13-19, 22-28 and 30-39 under Provisional Nonstatutory Obviousness-Type Double Patenting

Claims 1-2, 5-11, 13-19, 22-28 and 30-39 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24-29 of copending Application No. 11/157,213.

Section 804 of the Manual of the Patent Examining Procedure (hereinafter "MPEP") at page 800-17, states:

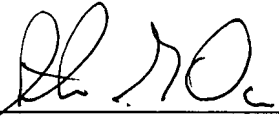
If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

Co-pending Application No. 11/157,213 was filed on June 20, 2005 and the instant application was filed on January 15, 2004. The instant application is the earlier filed of the two pending applications. The first Office Action for Application No. 11/157,213 has issued, which includes rejection under U.S.C. §112, first paragraph, for failing to meet the enablement requirement, and nonstatutory obviousness-type double patenting rejection. The provisional nonstatutory obviousness-type double patenting rejection would be the only rejection remaining in the instant application if the rejection under 35 U.S.C. §112, first paragraph discussed above is overcome. Therefore, Applicants respectfully request the provisional nonstatutory obviousness-type double patenting rejection be withdrawn if the Examiner withdraws the rejection under 35 U.S.C. §112, first paragraph in view of the claim amendments submitted herewith.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,
HAMILTON, BROOK, SMITH & REYNOLDS,
P.C.

By  _____

Steven G. Davis
Registration No. 39,652
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133

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